

REMARKS

At the time of the Fourth Office Action dated August 17, 2009, claims 1, 3, 5-11, 13-19, 21-25, 27, 29-35, and 37-40 were pending and rejected in this application.

Applicants have cancelled claims 1, 3, 5-8, 24, 27, and 29-32 to remove these claims from further consideration in this application. Applicants are not conceding in this application that those claims are not patentable over the prior art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the present application. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

CLAIMS 1, 3, 5-11, 13-19, 21-25, 27, 29-35, AND 37-40 ARE PROVISIONALLY REJECTED
UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING AS
BEING UNPATENTABLE OVER CLAIMS 1-14, 16, 20-27, AND 29-35 OF COPENDING U.S.
APPLICATION NO. 09/827,431 (HEREINAFTER THE '431 APPLICATION) AND CLAIMS 1-3, 5-8,
10-13, 15-18, AND 20 OF COPENDING U.S. APPLICATION NO. 09/972,434 (HEREINAFTER THE
'434 APPLICATION)

This rejection is traversed. As provided for in M.P.E.P. § 804(I)(B):

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications.

With regard to Nonstatutory Double Patenting rejections, M.P.E.P. § 804(II)(B)(1) states that

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992). This does not mean that one is precluded from all use of the patent disclosure.

The Examiner's statement of the rejection, however, evidences a complete lack of these factual inquiries in the Examiner's analysis. Instead, the Examiner alleges that both claims share certain limitations and asserts that "[t]hey all have a plurality of tiers, product list filters, elements that can be unilaterally filtered and product list filters." Simply identifying a few common limitations without explaining why the remaining limitations are obvious does not make a proper obviousness rejection.

Since (i) the Examiner has not established that these Graham factual inquiries were part of the Examiner's analysis; (ii) the Examiner has not identified the specific limitations recited in the present claims that are not allegedly disclosed by the claims of the '431 Application or by the claims of the '434 Application; and (iii) the Examiner has not set forth an articulated reasoning with some rational underpinning to support the legal conclusion that these specific limitations are

obvious in view of the claims of the '431 Application or in view of the claims of the '434 Application, Applicants respectfully submit that the Examiner has failed to establish a proper rejection of obviousness-type double patenting.

CLAIMS 1, 3, 5-11, 13-16, 25, 27, AND 29-32 ARE REJECTED UNDER THE SECOND

PARAGRAPH OF 35 U.S.C. § 112

On pages 6 and 7 of the Fourth Office Action, the Examiner asserted that claims 1, 3, 5-11, 13-16, 25, 27, and 29-32 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

As previously noted, claims 1, 3, 5-8, 24, 27, and 29-32 have been cancelled. Thus, the Examiner's rejection as to these claims is moot.

Regarding the Examiner's rejection of claims 9-11 and 13-16, the Examiner asserted the following on page 7 of the Fourth Office Action:

For example claim 9 states "communicating a user interface". How is an interface communicated? And the limitation taken as a whole reads "communicating a user interface to a contracting party, wherein the contract is generated by". Did Applicant mean to confer that instead of contract the "contracting party" is generated? Or instead of contract the "user interface" is generated?

Applicants respectfully submit that the phrase "communicating a user interface" is not vague or indefinite. In this regard, if the Examiner went onto the internet and entered a website having a particular interface, prior to the Examiner 'entering the website,' a user interface would have been communicated, from the server hosting the website, to the Examiner's computer.

The Examiner's confusion of the phrase "communicating a user interface to a contracting party, wherein the contract is generated by" reflects the Examiner failure to recognize that a comma "," separates the two clauses within this phrase. As such, these clauses are to be read independently. Therefore, as claimed, the contract is generated (and not the contracting party).

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 9-11 and 13-16 under the second paragraph of 35 U.S.C. § 112 has been overcome, and hence, Applicants respectfully solicit withdrawal thereof.

CLAIMS 1, 3, 5-11, 13-16, 25, 27, AND 29-32 ARE REJECTED UNDER 35 U.S.C. § 101

On pages 8 and 9 of the Fourth Office Action, the Examiner asserted that the claimed invention, as recited in claims 1, 3, 5-11, 13-16, 25, 27, and 29-32, fails to meet the requirements of 35 U.S.C. § 101. This rejection is respectfully traversed.

As previously noted, claims 1, 3, 5-8, 24, 27, and 29-32 have been cancelled. Thus, the Examiner's rejection as to these claims is moot.

Regarding claim 9 the Examiner asserted the following:

Here, applicant's method steps, fail the first prong of the Bilski decision since they are not tied to another statutory class and can be preformed [sic] without the use of a particular apparatus. Thus, claims 9-16 are non-statutory since they may be preformed [sic] within the human mind.

Notably absent from the Examiner's analysis is a claim construction as to the actual limitations being claimed. "[C]laim construction ... is an important first step in a § 101 analysis." In re Bilski, 545 F.3d 943 (Fed. Cir. 2008) (en banc). Many of the claimed limitations

are performed by a machine, and thus, claim 1 is tied to a particular machine. The Examiner's assertions that the steps "can be [performed] without the use of a particular apparatus" or "may be [performed] within the human mind" is completely without factual basis.

As discussed above with regard to the rejection under the second paragraph of 35 U.S.C. § 112, the communicating of a user interface requires the use of a machine since not all machines are capable of communicating user interfaces.. Also, the generation of user interfaces requires the use of a particular machine since not all machines are capable of generating user interfaces. Applicants are entirely unclear how a user interface can be both generated and communicated "within the human mind." An interface is a "place at which independent and often unrelated systems meet and act on or communicate with each other."¹ The Examiner has failed to identified the alleged independent systems within the human mind that the Examiner's interface provides a place to meet and act on or communicate with each other.

For the above-described reasons, Applicants respectfully solicit withdrawal of the imposed rejection of claims 9-11 and 13-16 under 35 U.S.C. § 101.

¹ <http://www.merriam-webster.com/dictionary/interface>.

CLAIMS 1, 3, 5-11, 13-19, 21-25, 27, 29-35, AND 37-40 ARE REJECTED UNDER 35 U.S.C.

§ 103 FOR OBVIOUSNESS BASED UPON CONKLIN ET AL., U.S. PATENT NO. 6,338,050

(HEREINAFTER CONKLIN), IN VIEW OF SHIRLEY ET AL., U.S. PATENT NO. 5,692,206

(HEREINAFTER SHIRLEY)

On pages 10-15 of the Fourth Office Action, the Examiner concluded that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Conklin and Shirley. This rejection is respectfully traversed.

On October 10, 2007, the Patent Office issued the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*," 72 Fed. Reg. 57,526 (2007) (hereinafter the Examination Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103." Within this section is the following quote from the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Referring to the first column on page 57,529 of the Examination Guidelines for Determining Obviousness, the following is a list of rationales that may be used to support a finding of obviousness under 35 U.S.C. § 103:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Upon reviewing the Examiner's analysis on page 12 of the Fourth Office Action, the Examiner appears to be employing rationale (G). However, the Examiner's analysis is not entirely clear as to what rationale the Examiner is employing. Applicants, therefore, request that the Examiner clearly identify the rationale, as described in the Examination Guidelines for Determining Obviousness, being employed by the Examiner in rejecting the claims under 35 U.S.C. § 103.

Referring again to rationale (G), as discussed on page 57,534 of the Examination Guidelines for Determining Obviousness, the following findings of fact must be articulated by the Examiner:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

- (2) a finding that there was reasonable expectation of success; and
- (3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Referring to the paragraph entitled "Office Personnel as Factfinders" on page 57,527 of the Examination guidelines, the following was stated:

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set forth the factual inquiries that are to be applied when establishing a background for determining obviousness under 35 U.S.C. 103. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of the prior art;
- (B) Ascertain the differences between the prior art and the claims at issue;
- (C) Resolve the level of ordinary skill in the pertinent art; and
- (D) Evaluate any indicia of nonobviousness.

However, in order to make a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. See *In re Paulsen*, 30 F.3d 1475,

1479 (Fed. Cir. 1994). See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process.") See Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

Conklin

On page 10 of the Fourth Office Action, the Examiner asserted the following as to the teachings of Conklin:

storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract, storing at least one from the compilation of business rules, generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract,. (Conklin: col. 21 - relational structuring of database; col.23 - storing of negotiations and results data; detailed rules for ordering);

The Examiner's analysis is entirely deficient. Conklin does not disclose the claimed "at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract" or "at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules." The claimed invention refers to (i) a "compilation of business rules;" (ii) "business rules comprising a plurality of rules available to be selected for inclusion in the contract;" (iii) "at least one terms and condition set;" (iv) "selected rules;" and (v) the "conditions set containing parameters corresponding to selected rules from the compilation of business rules."

The Examiner's analysis refers to generic "negotiations and results data; detailed rules for ordering." At the outset, the "detailed rules for ordering" are not available to be selected for

inclusion in the contract. Instead, Conklin teaches that "a sponsor 06 will usually want to establish more detailed rules for the ordering and processing of proposals." Thus, the rules are not intended to be placed into the proposal, but instead, the rules are for processing the proposal. Thus, the Examiner has mischaracterized the scope and content of Conklin.

Regarding the "negotiations and results data," although Conklin teaches that this information is stored, the Examiner has failed to put forth any reasoned analysis that establishes that the stored of the "negotiations and results data" corresponds to limitation (i) through (v) discussed above. Thus, the Examiner has failed to present an accurate characterization of the scope and content of Conklin.

As to the claimed "interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract," the Examiner asserted the following on page 11 of the Fourth Office Action:

and interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract (Conklin: cols. 19 and 21 and col. 22, lines 1-40 — authoring process integrated with databases; relational structuring of databases; "databases 225 created according to the present invention use a combination of record, filed, relational names and delimiters to interrelate the elements within; Data is kept secure with firewalls and SSL encryptions; col. 20, lines 45-65 — "the present invention protects the documents with separate user names, passwords and access levels for each inquirer"; col. 21, "Unique id's feature is used to insure the proper data is found and transmitted. That is, the present invention associates unique identifiers (id's) with each sponsor, participant, and type of data or transaction. Since database functions are integrated directly with the other functions of the invention, faster processing and updating of the database is enabled."; col. 24, lines 15-60 - final document is noted as complete);

Applicants are entirely unclear how these alleged findings of fact have anything to do with the claimed limitations at issue. None of these features correspond to the claimed interlocking. As such, the Examiner has again failed to properly characterize the scope and content of Conklin.

For the above-described reasons, the Examiner has failed to establish that the claimed invention, as recited in claims 9-11, 13-16, 21-24, 33-35, and 37-40, would have been obvious within the meaning of 35 U.S.C. § 103. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 9-11, 13-16, 21-24, 33-35, and 37-40 under 35 U.S.C. § 103 for obviousness based upon Conklin and Shirley.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: November 17, 2009

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320